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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/439,332 11/12/99 DISHON

J 99-0225

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EXAMINER

IVAR M KAARDAL
KAARDAL AND ASSOCIATES PC
3500 SOUTH FIRST AVE CIRCLE SUITE 250
SIOUX FALLS SD 57105-5807

DEXTER, J.

ART UNIT

PAPER NUMBER

3724

9

DATE MAILED:

09/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/439,332	Applicant(s) Dishon et al.
	Examiner Clark F. Dexter	Art Unit 3724
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
<p>Period for Reply</p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
<p>Status</p> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Jul 9, 2001</u></p> <p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
<p>Disposition of Claims</p> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1, 4-11, and 13-22</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input checked="" type="checkbox"/> Claim(s) <u>1 and 4-11</u> is/are allowed.</p> <p>6) <input type="checkbox"/> Claim(s) _____ is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input checked="" type="checkbox"/> Claims <u>13-22</u> are subject to restriction and/or election requirement.</p>		
<p>Application Papers</p> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<p>Priority under 35 U.S.C. § 119</p> <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). 		
<p>*See the attached detailed Office action for a list of the certified copies not received.</p> <p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>		
<p>Attachment(s)</p> <p>15) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p> <p>18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>20) <input type="checkbox"/> Other: _____</p>		

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DETAILED ACTION

1. The amendment filed July 9, 2001 has been entered. It is noted that in view of the new amendment practice under 37 CFR 1.121 which became mandatory for all amendments on March 1, 2001, and due to the limited amount of examining time per application, if the amendment contains changes to existing language that requires a marked-up version showing those changes, the Examiner is relying upon the marked-up version(s) for examination of the application. It is applicant's responsibility to ensure that the clean version(s) is (are) the same as the marked-up version(s). It is further noted that the clean version(s) is (are) considered to be the Official version(s).

Allowable Subject Matter

2. Claims 1 and 4-11 are allowable over the prior art of record.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered

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claims previously presented (whether entered or not). New claims 13-21 were filed with two claim 15's. Therefore, misnumbered claims 15-21 have been renumbered 16-22.

Election/Restriction

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 13 and 14, drawn to a cutting machine with a specific frame configuration, classified in class 83, subclass 859.
 - II. Claims 13, 15 and 17, drawn to a cutting machine with a specific cutting means configuration, classified in class 83, subclass 331.
 - III. Claims 13 and 16, drawn to a cutting machine with a specific control structure, classified in class 83, subclass 211.
 - IV. Claims 13 and 18, drawn to a cutting machine with a specific paper handling structure, classified in class 83, subclass 167.
 - V. Claims 13, 19, 20 and 22, drawn to a cutting machine with multiple paper cutting and delivery means, classified in class 83, subclass 701.
 - VI. Claims 13 and 21, drawn to a cutting machine with a specific actuating means configuration, classified in class 83, subclass 72.
5. Claims 13-22 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the specific frame configuration of Group I). It is noted that if claim 13 as originally filed is part of an elected group and determined to be

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patentable, rejoinder of claims 13-22 will be considered. It is further noted that claim 13 is listed as part of groups I-VI but is not considered to be part any of these groups. Rather, claim 13 recites subject matter that is common to all of the groups and has been shown as part of each group for clarity (i.e., so that it is clear which claims are part of which group). Further, because claim 13 includes subject matter that is common to all of the groups, it is not considered to be independent or distinct from any of the groups. Therefore, claim 13 will be examined upon election of one of the groups.

6. The inventions are distinct, each from the other because of the following reasons:

Group I vs Groups II-VI

7. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of the cutting means configuration of group II for patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the specific details of the frame configuration of group I for patentability as evidenced by the omission thereof from group II.

8. Inventions of groups I and III are separate inventions. They are distinct because the invention of group I does not require the specific details of the control structure of group III for patentability as evidenced by the omission thereof from group I, and the invention of group III does not require the specific details of the frame configuration of group I for patentability as evidenced by the omission thereof from group III.

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9. Inventions of groups I and IV are separate inventions. They are distinct because the invention of group I does not require the specific details of the paper handling structure of group IV for patentability as evidenced by the omission thereof from group I, and the invention of group IV does not require the specific details of the frame configuration of group I for patentability as evidenced by the omission thereof from group IV.

10. Inventions of groups I and V are separate inventions. They are distinct because the invention of group I does not require the multiple paper cutting and delivery means of group V for patentability as evidenced by the omission thereof from group I, and the invention of group V does not require the specific details of the frame configuration of group I for patentability as evidenced by the omission thereof from group V.

11. Inventions of groups I and VI are separate inventions. They are distinct because the invention of group I does not require the specific details of the actuating means of group VI for patentability as evidenced by the omission thereof from group I, and the invention of group VI does not require the specific details of the frame configuration of group I for patentability as evidenced by the omission thereof from group VI.

Group II vs Groups III-VI

12. Inventions of groups II and III are separate inventions. They are distinct because the invention of group II does not require the specific details of the control structure of group III for patentability as evidenced by the omission thereof from group II, and the invention of group III

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does not require the specific details of the cutting means configuration of group II for patentability as evidenced by the omission thereof from group III.

13. Inventions of groups II and IV are separate inventions. They are distinct because the invention of group II does not require the specific details of the paper handling structure of group IV for patentability as evidenced by the omission thereof from group II, and the invention of group IV does not require the specific details of the cutting means configuration of group II for patentability as evidenced by the omission thereof from group IV.

14. Inventions of groups II and V are separate inventions. They are distinct because the invention of group II does not require the multiple paper cutting and delivery means of group V for patentability as evidenced by the omission thereof from group II, and the invention of group V does not require the specific details of the cutting means configuration of group II for patentability as evidenced by the omission thereof from group V.

15. Inventions of groups II and VI are separate inventions. They are distinct because the invention of group II does not require the specific details of the actuating means of group VI for patentability as evidenced by the omission thereof from group II, and the invention of group VI does not require the specific details of the cutting means configuration of group II for patentability as evidenced by the omission thereof from group VI.

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Group III vs Groups IV-VI

16. Inventions of groups III and IV are separate inventions. They are distinct because the invention of group III does not require the specific details of the paper handling structure of group IV for patentability as evidenced by the omission thereof from group III, and the invention of group IV does not require the specific details of the control structure of group III for patentability as evidenced by the omission thereof from group IV.

17. Inventions of groups III and V are separate inventions. They are distinct because the invention of group III does not require the multiple paper cutting and delivery means of group V for patentability as evidenced by the omission thereof from group III, and the invention of group V does not require the specific details of the control structure of group III for patentability as evidenced by the omission thereof from group V.

18. Inventions of groups III and VI are separate inventions. They are distinct because the invention of group III does not require the specific details of the actuating means of group VI for patentability as evidenced by the omission thereof from group III, and the invention of group VI does not require the specific details of the control structure of group III for patentability as evidenced by the omission thereof from group VI.

Group IV vs Groups V-VI

19. Inventions of groups IV and V are separate inventions. They are distinct because the invention of group IV does not require the multiple paper cutting and delivery means of group V

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for patentability as evidenced by the omission thereof from group IV, and the invention of group V does not require the specific details of the paper handling structure of group IV for patentability as evidenced by the omission thereof from group V.

20. Inventions of groups IV and VI are separate inventions. They are distinct because the invention of group IV does not require the specific details of the actuating means of group VI for patentability as evidenced by the omission thereof from group IV, and the invention of group VI does not require the specific details of the paper handling structure of group IV for patentability as evidenced by the omission thereof from group VI.

Group V vs Group VI

21. Inventions of groups V and VI are separate inventions. They are distinct because the invention of group V does not require the specific details of the actuating means of group VI for patentability as evidenced by the omission thereof from group V, and the invention of group VI does not require the multiple paper cutting and delivery means of group V for patentability as evidenced by the omission thereof from group VI.

22. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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23. A telephone call was made to on to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

24. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
September 20, 2001